REMARKS

In the Office Action mailed August 1, 2008 from the United States Patent and Trademark Office, claim 9 was objected to, claims 1-9, 11, 13, 14, and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,149 to Warmus et al. (hereinafter "Warmus") in view of U.S. Patent No. 5,664,178 to Sinofsky (hereinafter "Sinofsky"), and claims 10, 12, 15-17, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky in view of allegedly well-known prior art.

Claim Objection:

Claim 9 has been amended as requested and withdrawal of the objection is requested.

Rejections under 35 U.S.C. § 103(a):

Claims 1-9, 11, 13, 14, and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of Sinofsky, and claims 10, 12, 15-17, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus and Sinofsky in view of allegedly well-known prior art. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that "the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) In showing that one of ordinary skill in the art would have found it obvious to combine the teachings of multiple references, it is improper to combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that one of skill in the art would not have found it obvious to combine the cited references to arrive at the claimed invention. Applicant therefore submits that the Office Action has failed to show how one of skill in the art would have found it obvious to overcome the differences between the prior art and the claimed invention to arrive at the claimed invention.

One of Skill in the Art Would Not Find It Obvious to Combine Warmus and Sinofsky:

In the Office Action, Applicant's assertion that one of skill in the art would not find it obvious to combine the references in the manner proposed in the Office Action was rejected. Applicant respectfully submits again that one of skill in the art would not find it obvious to combine references in the manner proposed to arrive at the claimed invention.

Specifically, as has been previously set forth and contrary to the position of the Office Action, Sinofsky does not teach a single file of the type claimed in the instant claim set.

Sinofsky specifically teaches "a compound document" that "is a disk file that contains data

generated by various applications." (Col. 3, lines 8-10, a portion of the language relied on in the

Office Action, emphasis added.) The compound document provides access by the various

applications to their native data within the compound document, thereby preventing one

application from needing the ability to access all the different types of data. (Col. 4 line 62-Col.

5 line 9)

Thus, Sinofsky teaches that each file entity in the file bundle is opened by a separate

application supporting the format of the file entity. (Col. 4 line 62-Col. 5 line 9) This is

necessary in Sinofsky since the pages are originally stored in different formats. (Col. 4 lines 60-

67) Thus, one of skill in the art of printing documents without a printer driver would not find it

obvious to utilize a file bundle requiring multiple applications to open the sub-files of the

Sinofsky file bundle as is required by the proposed combination. The proposed combination

would require cumbersome processing by multiple applications after a document had already

been sent to a printer.

Additionally, the compound document as taught by Sinofsky only teaches combining

document components in a way that provides for page ordering between files of different

formats. Specifically, column 5, lines 14-18 of Sinofsky teaches:

> FIG. 4 is a schematic diagram of sample data structures for storing data in an
> embodiment of the present invention. File bundle 410 contains directory 411 and
> files 412, 413, and 414. The directory structure and each file are shown as
> logically contiguous.

Similarly, Sinofsky only discloses using links from a top-level directory to the file components

to specify file order of the file components:

> The file bundle file data structures, such as data structures 440, 450, and 460, each
> contain a pointer to the start of the file bundle file within the file bundle, a file

pointer for the file bundle file, and the handle of the file bundle within the
FBTable 430.

(Col. 5 lines 42-46). Therefore, while Sinofsky teaches a file bundle of multiple file types, Sinofsky fails to teach a single file of a type that could be used in the manner disclosed in the claims, that is, one of a single format with linked sub-images to be processed by a printing device without using a printer driver.

The Cited References Fail to Teach All Claim Limitations:

The claims have been amended to more clearly distinguish over the cited references, although Applicant does not concede that the prior claims were made obvious by the cited references. Applicant instead has amended the claims to seek hastened allowance of the claims.

Claim 1, as amended, requires: "rendering the rendering job at a rendering device without using a printer driver, wherein the rendering device: receives the single file in the native format; and renders the single file, wherein the one or more sub-images are rendered as parts of the one or more pages of the document based on an association process, wherein the association process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process." Such limitations are not taught by the cited references. Specifically, Warmus does not teach a rendering device that renders a single file having sub-images that are rendered as parts of pages of the file. Such limitations are also not taught by Sinofsky, as Sinofsky teaches a compound document accessed by multiple applications, as set forth above.

Claim 13, as amended, requires: "providing one or more electronic tags of the TIFF document file to perform at least one of: supporting an overlay of the multiple sub-images on the page; supporting an underlay of the multiple sub-images on the page; supporting a composite of the multiple sub-images on the page; specifying a merge order of the multiple sub-images on the page; specifying a location for merging the multiple sub-images on the page; and specifying any

scaling of the multiple sub-images; and selectively rendering the TIFF image based on the electronic tags." Such limitations are not taught by Sinofsky or Warmus, as neither reference teaches TIFF electronic tags to perform the recited functions. While Warmus teaches an overlay process, Warmus does not teach TIFF electronic tags to perform an overlay.

Claim 19, as amended, requires: "initiating a rendering job of a document as a single file, wherein the rendering job is in a native image format that supports at least one of (i) multiple pages, and (ii) multiple images; storing one or more document indicia as separate sub-images in the single file in the native image format along with images representing one or more pages of the document; providing links within the file linking the one or more pages of the document with one or more of the sub-images." Such limitations are not taught by Sinofsky or Warmus, as neither reference teaches images and sub-images linked within a single file in the manner recited.

Claim 8, as amended, recites: "wherein the one or more sub-images are placed at one or more locations of the one or more pages of the document and at one or more scales defined by information included in the single file, the information being defined independently of the pages of the document." Similarly, claim 24, as amended, recites: "wherein the native format is a tagged image file format and the sub-images are placed at a location of the pages of the document and at a scale defined by tags included in an image file directory of the single file, the tags therefore being defined independently of the pages of the document defined by the tagged image file format." Such limitations are not taught by either Sinofsky or Warmus. In the claimed invention, the sub-images and tags are independently defined from the pages where they are inserted. Therefore, the sub-images may be placed anywhere as defined by the tags. In contrast, in the system of Warmus, the variable printing information is placed at fixed locations defined by the master template file. In other words, the Warmus variable data represents unfilled

holes in the pages. (See Figures 6a and 7a, and accompanying discussion at Col. 9 line 45-Col.
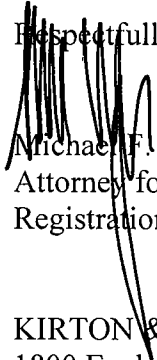
10 line 25.)

For at least the above reasons, Applicant respectfully requests removal of all rejections

under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the

claims are now in condition for allowance. Accordingly, Applicant requests favorable

reconsideration. If the Examiner has any questions or concerns regarding this communication,

the Examiner is invited to call the undersigned.

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Respectfully submitted,

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